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Michael Langer

740-65

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THE MAXHAM FIRM

9330 SCRANTON ROAD, SUITE 350

SAN DIEGO, CA 92121

EXAMINER

ALI, HATEM M

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/089,580	Applicant(s) LANGER ET AL.	
	Examiner HATEM ALI	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-23 and 25-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-23 and 25-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a **Final action** on merits in response to a communication received on **5/30/2008**.

Acknowledgement

2. The **new claims 25-27** and no amendments (previously cancelled **claims 1-9** and **24**) have been entered. As such **claims 10-23** and **25-27** are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 26-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the claim 26, lines 12+, the recitation, "sending to the payment gateway via the customer's mobile wireless Internet terminal, a customer message that includes said transaction data received by the customer from the provider" is a new mater and not found in specification and in claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1- 9 (cancelled).

5. **Claims 10-23 and 25-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Stadelmann** (6,415,156) in view of **Hunt** et al (6,223,213).

As per claim 10, Stadelmann discloses a method of payment for goods or services on the Internet (**col.1**, line 18; via **Internet**, on line services) by means of a mobile wireless Internet terminal (**col.1**, lines 2-7; via a mobile radio telephone with GSM system), the method comprising;

initiating a payment transaction (**col. 1**, lines 54-65);

providing a customer with access to a payment gateway (**col. 2**, lines 13-20; via the application **41** as the "validation Platform") via said mobile wireless Internet terminal, wherein said payment gateway is located by an **IP** address (**col. 3**, lines 24-30; via inter alia IMSI in **SIM card 10**);

allowing a provider access to said payment gateway via a server (**col.4**, lines 64- 67 through **col.4**, lines 1-2), wherein information about the customer is stored in said payment gateway;

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establishing a minipayment account in said payment transaction (**col. 2**, lines 50-51);

transmitting from said server, as a provider message, transaction data including provider identification information, payment option supported by the provider, and the IP address of the payment gateway, to the customer's mobile wireless Internet terminal and also to said payment gateway (**col. 1**, lines 55-65; via goods ordering process);

adding the customer's temporary IP address (**SIM card 10**) as customer identification;

allowing the customer to review said transaction data and select a payment option; sending the transaction data, as a customer message to the payment gateway, said transaction data having been received by the customer from the provider (**col. 3**, lines 12-20);

synchronizing said provider and customer messages in the payment gateway (**col. 3**, lines 12-20);

comparing said provider and customer messages to determine whether they match (**col. 3**, lines 20-25; via if he agrees with the price and the conditions);

determining and checking the customer's Mobile Subscriber Integrated Services Digital Network (MSISDN) number (**col. 2**, lines 5-25; via SIM card **10**, **GSM** or UMTS and SMSC **41** as implied equivalent in the limitation of utility) and customer information on the basis of the customer's IP address (**SIM card 10**); and

performing a deduction from the minipayement account online if said provider and customer messages match (**col. 4**, lines 1+; via customer account to be debited. ... stored ... by the customer or in a data base in the validation platform **42**).

Stadelmann fails explicitly to disclose the steps of synchronizing said provider and customer messages in the payment gateway, comparing said provider and customer messages to determine whether they match.

However, **Hunt** being in the same field of invention discloses that the steps of synchronizing said provider and customer messages in the payment gateway, comparing said provider and customer messages=(**col.5**, lines 12-65; via at stage **230**, a net sale transaction, correlation and analysis at line 22, synchronized data stored in the transaction database at line 40).

Therefore, it would have been obvious to an ordinary skill in the art at the time of invention was made to modify the disclosure of **Stadelmann** and to include the features mentioned and taught by **Hunt** to facilitate the tracking shopping cart-related activity.

As per claim 11, Stadelmann discloses no electronic financial information and no customer information is stored in said terminal after the transaction (**col. 3**, lines 40-45; via but no data concerning purchased service, product or information)

As per claims 12 and 13, Stadelmann discloses the step of securing each payment transaction with a personal identification number (PIN) (**col. 4**, line 1; via PIN).

As per claims 14 and 15, Stadelmann further discloses sensitive data remains securely in the mobile wireless network and is not transmitted over the Internet (**col. 3**, lines 23-29; via subscriber Identity stored in secured memory area of SIM card 10).

As per claims 16 and 17, *Stadelmann* also discloses no additional encryption methods are necessary (**col. 2 and 3**, lines 66- 67 and 1-2; via may be preferred by TTP but not required).

As per claims 18 and 19, *Stadelmann* further discloses no additional authentication method is necessary because the authentication of the customer is performed by the mobile wireless network (**col. 2**, lines 17-20; via agreement and SIM card 10).

As per claims 20 and 21, *Stadelmann* discloses the provider's server recognizes which GSM operator the customer belongs to on the basis of the IP address range (**col. 2**, lines 4-55; via services center 41, computer, database 421 and address in SIM card 10).

As per claims 22 and 23, *Stadelmann* also discloses that the payment gateway generates an electronic invoice for the dealer's account for each transaction performed (**col. 4**, lines 5- 20; via automatic report by e-mail or fax).

24. (Cancelled)

As per claim 25, *Stadelmann* discloses a method of payment for goods or services on the Internet (**col.1**, line 18; via **Internet**, on line services) by means of a mobile wireless Internet terminal (**col.1**, lines 2-7; via a mobile radio telephone with **GSM** system), the method comprising;

initiating a payment transaction (**col. 1**, lines 54-65);

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providing a customer with access to a payment gateway (**col. 2**, lines 13-20; via the application 41 as the "validation Platform") via said mobile wireless Internet terminal, wherein said payment gateway is located by an IP address (**col. 3**, lines 24-30; via inter alia IMSI in SIM card 10);

allowing a provider access to said payment gateway via a server (**col.4**, lines 64- 67 through **col.4**, lines 1-2), wherein information about the customer is stored in said payment gateway;

establishing a minipayment account in said payment transaction (**col. 2**, lines 50-51);

transmitting from said server, as a provider message, transaction data including provider identification information, payment option supported by the provider, and the IP address of the payment gateway, to the customer's mobile wireless Internet terminal and also to said payment gateway (**col. 1**, lines 55-65; via goods ordering process);

adding the customer's temporary IP address (**SIM card 10**) as customer identification;

allowing the customer to review said transaction data and select a payment option; sending the transaction data, as a customer message to the payment gateway, said transaction data having been received by the customer from the provider (**col. 3**, lines 12-20);

performing a deduction from the minipayment account online if said provider and customer messages match (**col. 4**, lines 1+; via customer account to be debited. ... stored ... by the customer or in a data base in the validation platform **42**).

Stadelmann fails explicitly to disclose the steps of synchronizing said provider and customer messages in the payment gateway, comparing said provider and customer messages to determine whether they match.

However, **Hunt** being in the same field of invention discloses that the steps of synchronizing said provider and customer messages in the payment gateway, comparing said provider and customer messages (**col.5**, lines 12-65; via at stage **230**, a net sale transaction, correlation and analysis at line 22, synchronized data stored in the transaction database at line 40).

Therefore, it would have been obvious to an ordinary skill in the art at the time of invention was made to modify the disclosure of **Stadelmann** and to include the features mentioned and taught by **Hunt** to facilitate the tracking shopping cart-related activity.

As per claim 26, **Stadelmann** discloses a method of payment for goods or services on the Internet by means of a mobile wireless Internet terminal, the method comprising;

establishing a minipayment account for a customer, wherein information about the customer's minipayment account is stored in a payment gateway (**col. 2**, lines 50-51; via the customer must set up a monetary account in the customer data base **421** [implied associated with gateway]);

initiating a payment transaction for the customer(**col. 1**, lines 54-65);

transmitting from a server to the customer's mobile wireless Internet terminal and also to said payment gateway, a provider message, including (a) transaction data

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including provider identification information and payment options supported by the provider, and (b) the IP address of the payment gateway (**col. 1**, lines 55-68; via goods ordering process and implied other information with the system);

including the customer's IP address as customer identification in the provider message sent to the payment gateway (**SIM** card **10**, implied to the gateway);

sending to the payment gateway via the customer's mobile wireless Internet terminal, a customer message that includes said transaction data received by the customer from the provider and a payment option selected by the customer (**col.3**, lines 21+; via if he agrees with the price and the conditions [implied options] ... customer confirm he order with short message (**SMS**, USSD or **e-mail** ... the confirmation preferably contains all the order data[implied receipt from the provider]); and

performing a deduction from the minipayment account online if said provider and customer messages match(**col. 4**, lines 1+; via customer account to be debited. ... stored ... by the customer or in a data base in the validation platform **42**).

Stadelmann fails explicitly to disclose the steps of synchronizing said provider and customer messages in the payment gateway, comparing said provider and customer messages to determine whether they match.

However, **Hunt** being in the same field of invention discloses that the steps of synchronizing said provider and customer messages in the payment gateway, comparing said provider and customer messages=(**col.5**, lines 12-65; via at stage **230**, a

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net sale transaction, correlation and analysis at line 22, synchronized data stored in the transaction database at line 40).

Therefore, it would have been obvious to an ordinary skill in the art at the time of invention was made to modify the disclosure of **Stadelmann** and to include the features mentioned and taught by **Hunt** to facilitate the tracking shopping cart-related activity.

6. **Claim 27** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Stadelmann** and **Hunt** in view of **Homes** et al (6,178,331).

As per claim 27. **Stadelmann** fails explicitly to disclose a method, wherein information about the customer is stored in the payment gateway, the method comprising: via the customer's IP address, determining the customer's Mobile Subscriber Integrated Services Digital Network (MSISDN) number; and with the customer's MSISDN number, searching the stored customer information to determine whether the customer information has been stored correctly for the selected payment option.

However, **Homes** discloses a method according to claim 26, wherein information about the customer is stored in the payment gateway, the method comprising: via the customer's IP address, determining the customer's Mobile Subscriber Integrated Services Digital Network (MSISDN) number; and with the customer's MSISDN number, searching the stored customer information to determine whether the customer information has been stored correctly for the selected payment option (**Fig.1, col.2,**

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lines 64-68; via The gateway **101** ... the Internet **140** ... transport protocol [e.g., TCP/IP, etc] and **col.4**, lines 60+; via messages ... the Internet **140** ... a mobile phone **130**, the gateway **101** may create a new or temporary and unique reply **MSISDN number**).

Therefore, it would have been obvious to an ordinary skill in the art at the time of invention was made to modify the features mentioned by **Stadelmann** to include the disclosures as taught by **Homes** to facilitate the user of the mobile phone to reply to messages without knowing the address of the original sender [gateway **101**] for the execution of the purchase/related process.

Response to Arguments

7. **Applicant's** arguments with respect to **claims 1—23 and 25-27** have been considered but are moot in view of the new ground(s) of rejection.

Applicant argued (Remarks page 7, lines 13-15) that in Stadelmann system, does not include payment options ... provider message include payment options. **The Examiner** respectfully does not agree and refers to **Stadelmann** (col. 3, line 21+; via if he [customer] agrees with the price and the conditions, the customer can confirm the order with short message [... or e-mail] . The confirmation preferably contains all order data needed for the order [implied required payment option selection by the customer] ... A copy of the confirmation ... automatically communicated to the validation platform **42** either by the customer or by the service provider[**arrow F**]).

In response to **applicant's further argument** (Remark page 8, lines 19+), "such a modification ... **Hunt** is directed to a different field of invention and does not teach the steps of synchronizing provider and customer messages ... part of the method of payment" is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, **Hunt** (col.5, lines 12-65) discloses clearly at stage **230**, a net sale transaction, correlation and analysis at line 22, synchronized data stored in the transaction database at line 40).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hannula (6,366,893) discloses Method and Apparatus for Performing an Electric Payment Transaction in a Telecommunication Network

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HATEM ALI whose telephone number is (571)270-3021. The examiner can normally be reached on 8.00 to 6.00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on 571-272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Harish Dass
Primary Engineer

Hatem Ali
Examiner
Art Unit 3692

/Harish T Dass/
Examiner, Art Unit 3692